



GP 2811
#5/Election
1/25/02
JS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of:

ITO

Serial No.:

09/735,005

Filed:

December 12, 2000

For:

SEMICONDUCTOR DEVICE HAVING DUMMY ...

Group:

2811

Examiner:

T. Tran

DOCKET:

NEC 444

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JAN 23 2002
TECHNOLOGY CENTER 2800

Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

AMENDMENT A

Dear Sir:

In response to the Official Action Mailed November 29, 2001, provisional election is hereby made, with traverse, to prosecute the invention of Group II, comprising claims 12-23.

The restriction requirement is respectfully traversed. The Official Action has not established a prima facie justification for the requirement for election. The Official Action states, "In the instant case, unpatentability of the group I invention would not necessarily imply unpatentability of the method of the group II invention,.....".

In the Official Action, the reference made therein to unpatentability of the claims is irrelevant to a restriction requirement. A requirement for restriction has nothing to do with unpatentability of claims for any of the inventions being claimed. It is agreed that a rejection of any claim cannot be based on unpatentability implied to such a claim due to unpatentability of another claim. The sole basis for unpatentability resides in the statutes. The statutes do not authorize unpatentability to be implied from other claims of the same application. Nothing in the

statutes permits unpatentability of claims to be based on unpatentability being implied from unpatentable other claims. A restriction requirements has nothing to do with patentability or unpatentability.

The Official Action states, "....the device of the group 1 invention could be made by processes materially different from those of the group II invention. For example, forming field area by the LOCOS method instead of shallow trench method." Again, no prima facie basis for the restriction requirement has been made in the Official Action. There has been no factual basis for identifying a material difference arising from a change in the manufacturing process suggested by the Examiner. Thus, it is submitted that at least group I and group II should be examined together. Applicant does not traverse the restriction requirement as regards claims Group III.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements, not having been met here vis-à-vis Groups I and II respectively, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the claims of Groups I and II.

It should be noted that the restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicant provisionally elects to prosecute Group II, i.e. Claims 12-23, and it is requested that, without further action thereon, the remaining claims be retained in this application pending disposition of the application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

RESPECTFULLY SUBMITTED



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Washington, D.C. 20231 on December 11, 2001, at Manchester, New Hampshire.

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